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**TRANSMITTAL
FORM**

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Total Number of Pages in This Submission

21

Application Number

10/765,007

Filing Date

January 26, 2004

First Named Inventor

Schooler

Art Unit

3617

Examiner Name

Lars A. Olson

Attorney Docket Number

SHO002USPT03

ENCLOSURES (Check all that apply)

Fee Transmittal Form



Fee Attached



Amendment/Reply



After Final



Affidavits/declaration(s)



Extension of Time Request



Express Abandonment Request



Information Disclosure Statement



Certified Copy of Priority Document(s)

Reply to Missing Parts/
Incomplete ApplicationReply to Missing Parts
under 37 CFR 1.52 or 1.53

Drawing(s)



Licensing-related Papers



Petition

Petition to Convert to a
Provisional Application

Power of Attorney, Revocation



Change of Correspondence Address



Terminal Disclaimer



Request for Refund



CD, Number of CD(s) _____

☐ Landscape Table on CD

After Allowance Communication to TC

Appeal Communication to Board
of Appeals and InterferencesAppeal Communication to TC
(Appeal Notice, Brief, Reply Brief)

Proprietary Information



Status Letter

Other Enclosure(s) (please identify
below):

Credit Card Payment Form

Remarks

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name

Sherrill Law Offices PLLC

Signature

Printed name

Michael S. Sherrill

Date

26 Sep 05

Reg. No.

32,302

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:

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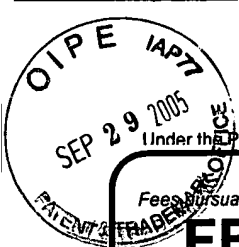
Alisa R. Hintzman

Date

Sept. 26, 2005

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Effective on 12/08/2004.

Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

FEE TRANSMITTAL
For FY 2005☒ Applicant claims small entity status. See 37 CFR 1.27**TOTAL AMOUNT OF PAYMENT** (\$) \$ 250.00**Complete if Known**

Application Number	10/765,007
Filing Date	January 26, 2004
First Named Inventor	Schooler
Examiner Name	Lars A. Olson
Art Unit	3617
Attorney Docket No.	SHO002USPT03

METHOD OF PAYMENT (check all that apply)☐ Check ☒ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): _____☒ Deposit Account Deposit Account Number: 19-2020 Deposit Account Name: Sherrill Law Offices

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, except for the filing fee☒ Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17 ☒ Credit any overpayments**WARNING:** Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**FEE CALCULATION****1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	_____
Design	200	100	100	50	130	65	_____
Plant	200	100	300	150	160	80	_____
Reissue	300	150	500	250	600	300	_____
Provisional	200	100	0	0	0	0	_____

2. EXCESS CLAIM FEES

Fee Description	Fee (\$)	Small Entity Fee (\$)
Each claim over 20 (including Reissues)	50	25
Each independent claim over 3 (including Reissues)	200	100
Multiple dependent claims	360	180

Total Claims	Extra Claims	Fee (\$)	Fee Paid (\$)	Multiple Dependent Claims
_____ - 20 or HP = _____	x _____	= _____		Fee (\$) Fee Paid (\$)

HP = highest number of total claims paid for, if greater than 20.

Indep. Claims	Extra Claims	Fee (\$)	Fee Paid (\$)
_____ - 3 or HP = _____	x _____	= _____	

HP = highest number of independent claims paid for, if greater than 3.

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
_____ - 100 = _____	/ 50 = _____	(round up to a whole number) x _____	= _____	

4. OTHER FEE(S)

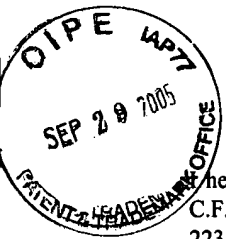
Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): Appeal Brief**Fees Paid (\$)**
\$ 250.00**SUBMITTED BY**

Signature	<u>Michael S. Sherrill</u>	Registration No. (Attorney/Agent) 32,302	Telephone 651-426-2400
Name (Print/Type)	Michael S. Sherrill		Date <u>26 Sep 05</u>

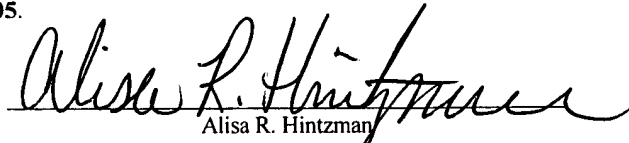
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Alisa R. Hintzman

APPEAL BRIEF			Docket No. SHO002USPT03
Serial No. 10/765,007	Filing Date January 26, 2004	Examiner Lars A. Olson	Group Art Unit 3617
Applicant:	Schooler		
Invention:	PERSONAL WATERCRAFT		

Mail Stop Appeal Brief - Patents
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Dear Sir:

This Appeal Brief is filed on appeal from the decision of the Examiner dated July 21, 2005 finally rejecting claims 1-7 and 9-11 in the above-referenced patent application.

REAL PARTY IN INTEREST

The real party in interest in connection with this appeal is the inventor Timothy C. Schooler.

RELATED APPEALS AND INTERFERENCES

Appellant and appellant's legal representative are unaware of any other appeal or interference which will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

09/29/2005 ZJUHR1 0000062 192020 10765007
01 FC:2402 250.00 DA

STATUS OF CLAIMS

The application was filed on January 26, 2004 as a continuation application with claims 1-37. Claims 18, 19, 25 and 28 were cancelled and claims 1-3, 12-14 and 26-27 amended in an Amendment and Response filed contemporaneously with the continuation application. A Notice of Allowance was mailed on December 30, 2004 and the issue fee paid on January 11, 2005. A Withdrawal From Issue notice was mailed April 25, 2005. Claim 1 was amended in an Amendment and Response transmitted June 15, 2005. Claims 1-17, 20-24, 26-27 and 29-37 remain pending in the application. Claims 1-7 and 9-11 have been finally rejected. Claims 12-17, 20-24, 26-27 and 29-37 have been allowed. Claim 8 has been objected to.

The rejection of claims 1-7 and 9-11 is appealed. A copy of the claims involved in this appeal is provided in the Appendix section of the Appeal Brief.

STATUS OF AMENDMENTS

No amendment has been filed subsequent to final rejection of the appealed claims.

SUMMARY OF CLAIMED SUBJECT MATTER

The embodiment of the present claimed invention claimed in rejected claims 1-7 and 9-11 is directed to personal watercraft [10] having (i) a hull [20] defining a deck [40] with a planar upper surface [41], and (ii) a plurality of pontoons [50] repositionably attached to the hull [20] with at least one pontoon [50s or 50sb and 50sq] attached proximate the starboard side [23] of the hull [20] and at least one pontoon [50p or 50pb and 50pq] attached proximate the port side [24] of the hull [20]. [Paragraphs 0047, 0048 and 0051 and Figures 1-9 and 21]. The pontoons [50] are laterally [y] and longitudinally [x] repositionable within a single plane relative to the hull [20] as between a storage position in which the pontoons [50] are generally longitudinally [x] aligned relative to the hull [20] and have a minimized lateral [y] distance between the pontoons [50] with at least a portion of the pontoons [50] transversely [z] positioned underneath the deck

[40], and a flotation position in which the pontoons [50] are shifted aft relative to the longitudinally [x] aligned storage position and have a maximized lateral [y] distance between the pontoons [50]. [Paragraphs 0007, 0008, 0049, 0055 and 0058, Figures 4, 6 and 8 (storage position) and Figures 1-3, 5 and 7 (flotation position)].

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

1. Whether claims 1, 7 and 9-11 are anticipated by Crisp (United States Patent No. 2,678,018).
2. Whether claims 2-6 are obvious over Crisp (United States Patent No. 2,678,018).

ARGUMENT

Objections/Rejections Under 35 U.S.C. §102

- 1.0 The examiner has rejected claims 1, 7 and 9-11 as anticipated by Crisp (United States Patent 2,678,018).*

SUMMARY OF CITED REFERENCE

The Crisp patent discloses a portable boat having a pair of pontoons repositionably attached to the hull as between (i) a nested position in which the pontoons are generally longitudinally aligned and tucked underneath the hull, (ii) a storage position in which the pontoons are shifted upward and laterally outward relative to the nested position, and (iii) an extended position in which the pontoons are shifted laterally outward and aft relative to the storage position. A copy of FIGs 2 and 5 from the Crisp patent are attached with the pontoons highlighted in yellow when in the nested position, highlighted in pink when in the storage position, and highlighted in green when in the extended position. For comparison purposes, a copy of FIGs 3-6 from applicant's patent application are also attached with the pontoons highlighted in pink when in the storage position, and highlighted in green when in the flotation

position. These same color-coded figures were provided to the Examiner in the Response to the Final Office Action.

LEGAL BASIS

An anticipation rejection under 35 U.S.C. § 102 requires that the cited reference(s) disclose each and every element of the claimed invention. *See, Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986); *Kloster Speedsteel AB et al. v. Crucible Inc. et al.*, 230 U.S.P.Q. 81, 84 (Fed.Cir. 1986). A reference anticipates a claim only when the reference discloses each and every element recited in the claim. *See, Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051 (Fed. Cir. 1987) and M.P.E.P. §2131. Accordingly, the “exclusion of a claimed element from a prior art reference is enough to negate anticipation by that reference.” *Atlas Powder Co. v. E.I. duPont De Nemours & Co.*, 224 U.S.P.Q. 409, 411 (Fed. Cir. 1984).

CRISP DOES NOT DISCLOSE EACH AND EVERY ELEMENT OF THE CLAIMED INVENTION

Crisp discloses a portable boat in which the pontoons are repositionable as between (i) a nested, storage and extended position in which the pontoons are generally longitudinally aligned and transversely tucked underneath the hull when nested, shifted transversely upward and laterally outward for storage, and shifted laterally outward and longitudinally aft when extended.

The relevant embodiment of the present claimed invention is directed to personal watercraft in which the pontoons are laterally and longitudinally repositionable within a single plane relative to the hull as between a storage position in which the pontoons are generally longitudinally aligned relative to the hull and have a minimized lateral distance between the pontoons with at least a portion of the pontoons transversely positioned underneath the deck, and a flotation position in which the pontoons are shifted aft relative to the longitudinally aligned storage position and have a maximized lateral distance between the pontoons.

Crisp does not disclose a structure permitting such repositioning of the pontoons. Rather Crisp discloses pontoons which (i) when repositioned from the nested position to the storage position are not shifted aft, (ii) when repositioned from the storage position to the extended position are never transversely positioned underneath the hull, and (iii) when repositioned from the nested position to the extended position require three-dimensional repositioning of the pontoons within two planes.

The Examiner's explanation of the basis for the rejection of claims 1, 7 and 9-11 over Crisp set forth in paragraph 11 of the final Office Action indicates that the Examiner has ignored the claim limitation requiring the pontoons to be "*laterally and longitudinally repositionable within a single plane relative to the hull as between a storage position ... and a flotation position*" as Crisp requires repositioning of the pontoons within two perpendicular planes to achieve repositioning of the pontoons from a first position "*in which the pontoons are generally longitudinally aligned relative to the hull and have a minimized lateral distance between the pontoons with at least a portion of the pontoons transversely positioned underneath the deck*" and a second position "*in which the pontoons are shifted aft relative to the longitudinally aligned storage position and have a maximized lateral distance between the pontoons*".

***Objections/Rejections
Under 35 U.S.C. § 103***

2.0 The examiner has rejected claims 2-6 as obvious over Crisp.

LEGAL BASIS

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, NOT in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). See, M.P.E.P. § 2143.

CRISP DOES NOT TEACH OR SUGGEST
ALL OF THE CLAIM LIMITATIONS
OF THE CLAIMED INVENTION

Claims 2-6 depend from claim 1. Applicant submits that claims 2-6 are patentable over Crisp for the same reason set forth above with respect to the patentability of claims 1, 7 and 9-11 over Crisp as Crisp does not disclose, teach or suggest a structure permitting repositioning of the pontoons as set forth in these claims.

CONCLUSION

Applicant respectfully submits that all rejected claims (claims 1-7 and 9-11) are in condition for allowance.

Respectfully submitted,

Date 26 Sep 05

By M. Sherrill
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4756 Banning Avenue, Suite 212
White Bear Lake, Minnesota 55110-3205
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CLAIMS APPENDIX

PENDING CLAIMS INVOLVED IN APPEAL

*United States Patent Application
Serial No. 10/765,007*

1. A personal watercraft, comprising:
 - (a) a hull defining a deck with a planar upper surface and having a bow, a stern, a starboard side, a port side, a longitudinally extending overall length and a laterally extending beam, and
 - (b) a plurality of pontoons repositionably attached to the hull with at least one pontoon attached proximate the starboard side and at least one pontoon attached proximate the port side,
 - (c) wherein the pontoons are laterally and longitudinally repositionable within a single plane relative to the hull as between a storage position in which the pontoons are generally longitudinally aligned relative to the hull and have a minimized lateral distance between the pontoons with at least a portion of the pontoons transversely positioned underneath the deck, and a flotation position in which the pontoons are shifted aft relative to the longitudinally aligned storage position and have a maximized lateral distance between the pontoons.
2. The personal watercraft of claim 1 wherein the deck has at least 16 ft² of a planar upper surface.
3. The personal watercraft of claim 1 wherein the deck has at least 20 ft² of a planar upper surface.
4. The personal watercraft of claim 1 wherein the personal watercraft has a maximum lateral width of between 3 feet and 4 feet when the pontoons are in the storage position.

5. The personal watercraft of claim 1 wherein the personal watercraft has a maximum longitudinal length of between 6 feet and 8 feet when the pontoons are in the storage position.
6. The personal watercraft of claim 1 wherein the personal watercraft has a maximum transverse height of between 1 foot and 3 feet when the pontoons are in the storage position.
7. The personal watercraft of claim 1 wherein the starboard side pontoon and the port side pontoon are independently repositionable.
9. The personal watercraft of claim 1 wherein:
 - (i) the starboard side pontoon is repositionably attached to the hull by at least one starboard side connector link with a proximal end pivotably attached to the hull for pivoting about a transverse pivot axis and a distal end pivotably attached to the starboard side pontoon for pivoting about another transverse pivot axis,
 - (ii) the port side pontoon is repositionably attached to the hull by at least one port side connector link with a proximal end pivotably attached to the hull for pivoting about a transverse pivot axis and a distal end pivotably attached to the port side pontoon for pivoting about another transverse pivot axis.
 - (iii) the port side pontoon is repositionably attached to the hull by at least one port side connector link with a proximal end pivotably attached to the hull for pivoting about a transverse pivot axis and a distal end pivotably attached to the port side pontoon for pivoting about another transverse pivot axis.
10. The personal watercraft of claim 1 wherein:
 - (i) the starboard side pontoon is repositionably attached to the hull by at least two longitudinally spaced starboard side connector links with each starboard side connector link having a proximal end pivotably attached to the hull for

- pivoting about a transverse pivot axis and a distal end pivotably attached to the port side pontoon for pivoting about another transverse pivot axis, and
- (ii) the port side pontoon is repositionably attached to the hull by at least two longitudinally spaced port side connector links with each port side connector link having a proximal end pivotably attached to the hull for pivoting about a transverse pivot axis and a distal end pivotably attached to the port side pontoon for pivoting about another transverse pivot axis.
11. The personal watercraft of claim 1 further comprising a means for releasably retaining the pontoons at a fixed lateral and longitudinal location when in the storage position, the flotation position and at least one intermediate position between the storage position and the flotation position.
12. A personal watercraft having a length and a width, comprising:
- (a) a hull defining a deck with a planar upper surface and having a bow, a stern, a starboard side, a port side, a longitudinally extending overall length and a laterally extending beam, and
 - (b) a plurality of pontoons repositionably attached to the hull with at least one pontoon positioned off a starboard bow of the hull, at least one pontoon positioned off a starboard quarter of the hull, at least one pontoon positioned off a port bow of the hull, and at least one pontoon positioned off a port quarter of the hull,
 - (c) wherein the pontoons are laterally and longitudinally repositionable as between a storage position having a minimized lateral and longitudinal distance between the pontoons to facilitate transportation and storage, and a flotation position having a maximized lateral and longitudinal distance between the pontoons to provide improved flotation stability relative to the storage position.
13. The personal watercraft of claim 12 wherein deck has at least 16 ft² of a planar upper surface.

14. The personal watercraft of claim 1 wherein the deck has at least 20 ft² of a planar upper surface.
15. The personal watercraft of claim 12 wherein the personal watercraft has a maximum lateral width of between 3 feet and 4 feet when the pontoons are in the storage position.
16. The personal watercraft of claim 12 wherein the personal watercraft has a maximum longitudinal length of between 6 feet and 8 feet when the pontoons are in the storage position.
17. The personal watercraft of claim 12 wherein the personal watercraft has a maximum transverse height of between 1 foot and 3 feet when the pontoons are in the storage position.

EVIDENCE APPENDIX

NONE

RELATED PROCEEDINGS APPENDIX

NONE

May 11, 1954

P. L. CRISP
PORTABLE BOAT

2,678,018

Filed Jan. 7, 1950

2 Sheets-Sheet 1

FIG. 1.

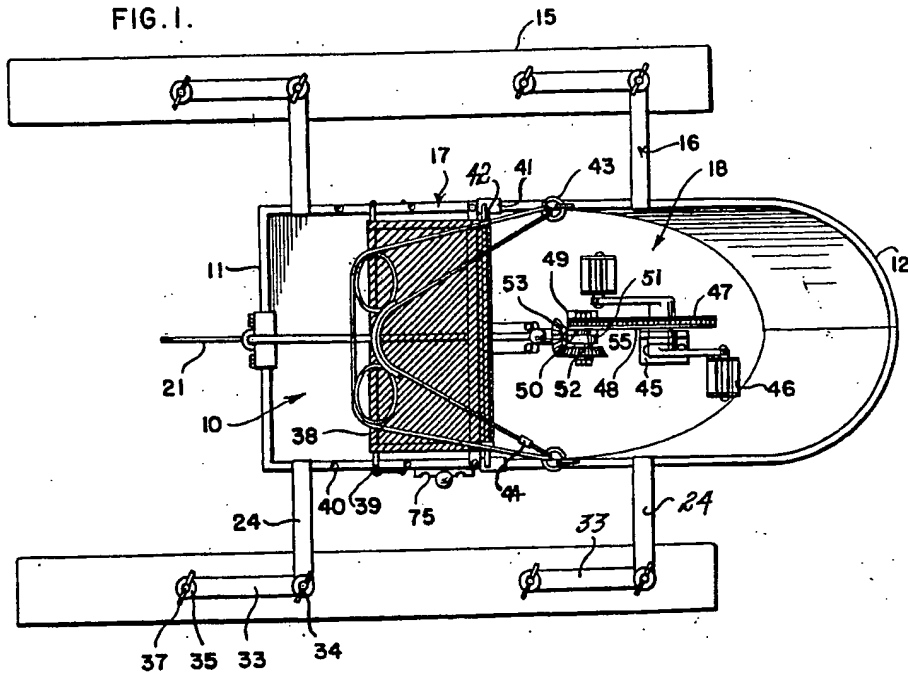
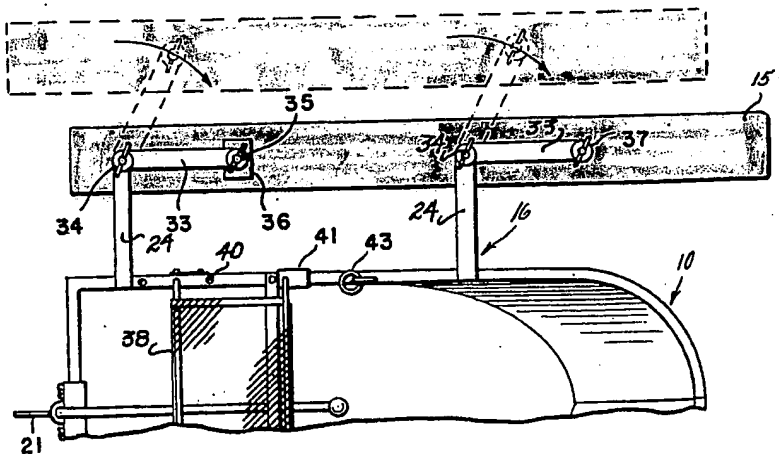


FIG. 2.



Inventor

PHILLIP L. CRISP

By

James W. Paxton
Agent.

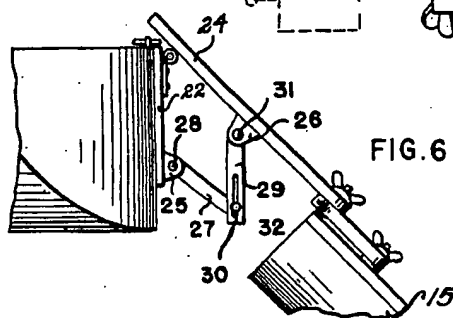
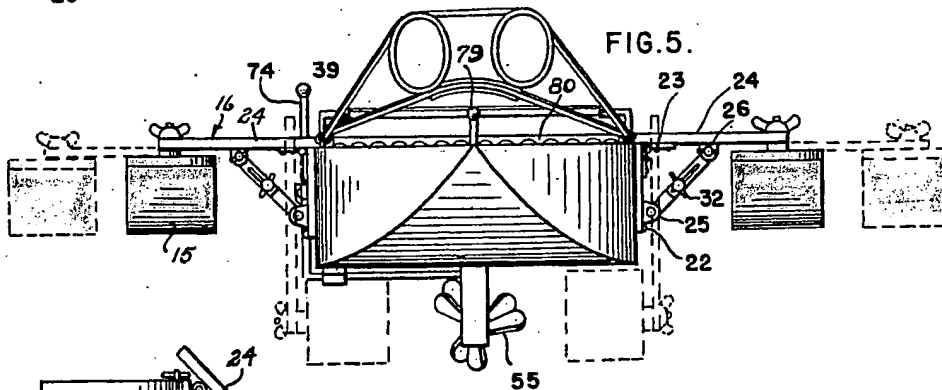
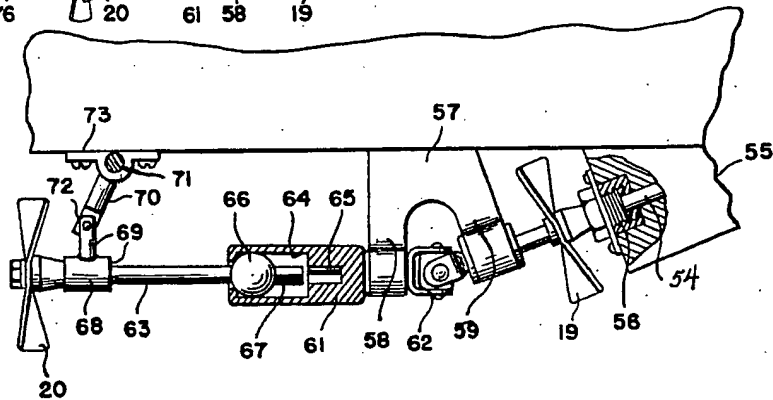
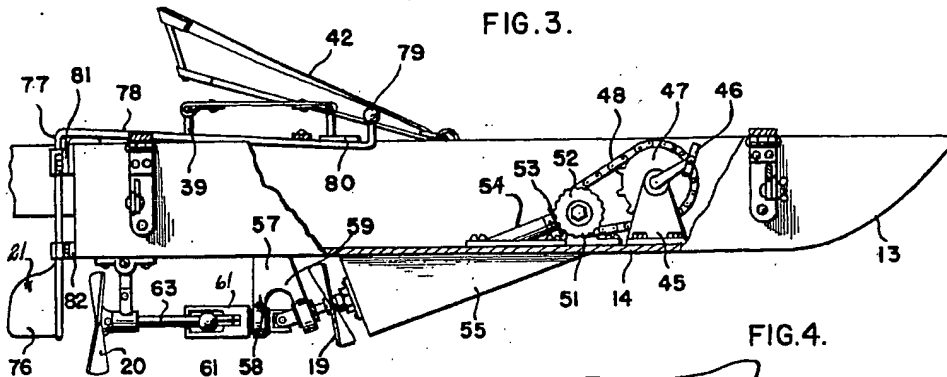
May 11, 1954

P. L. CRISP
PORTABLE BOAT

2,678,018

Filed Jan. 7, 1950

2 Sheets-Sheet 2



Inventor

PHILLIP L. CRISP

By

James C. [Signature]
Agent.

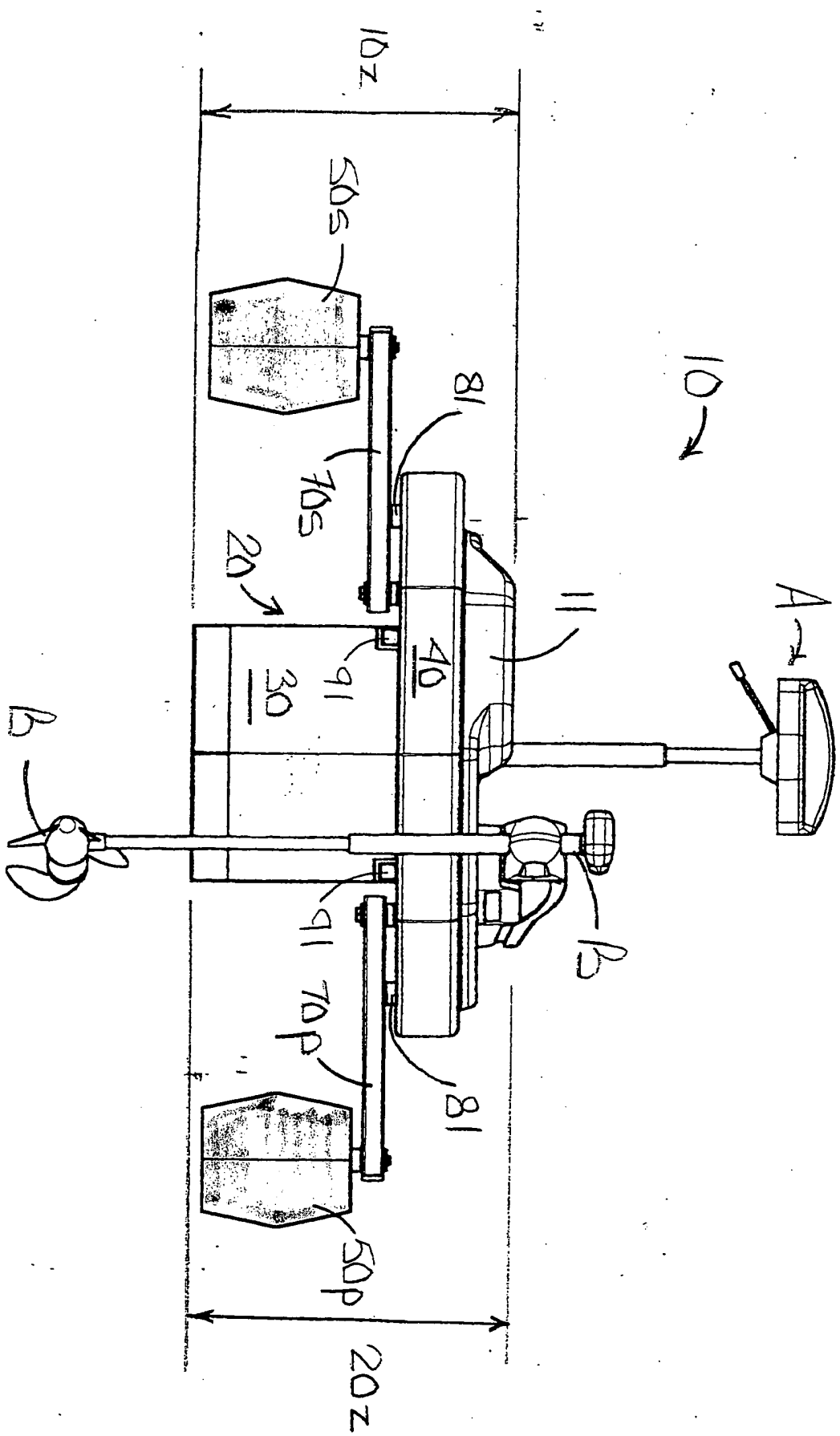


FIG. 3

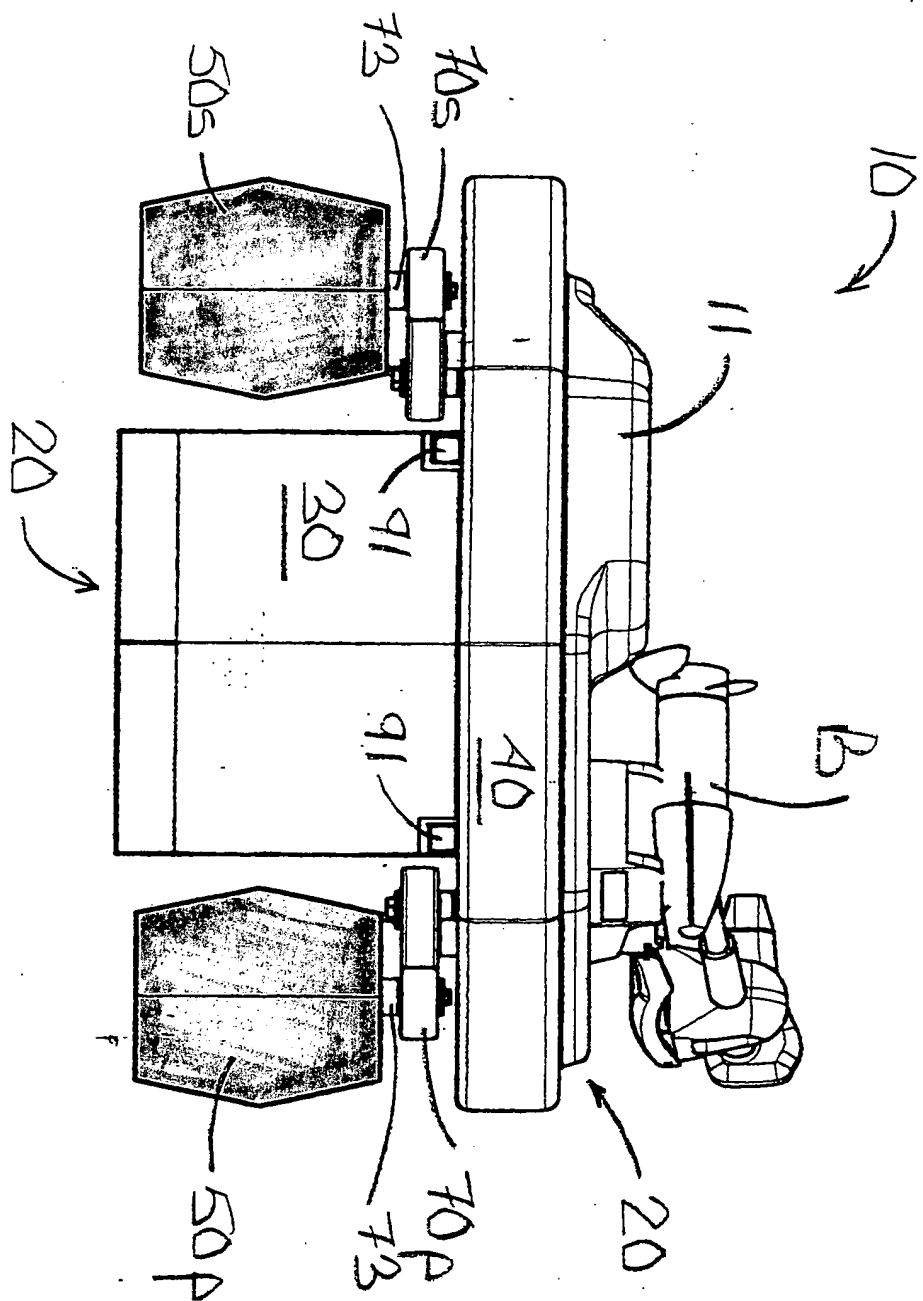


FIG. 4

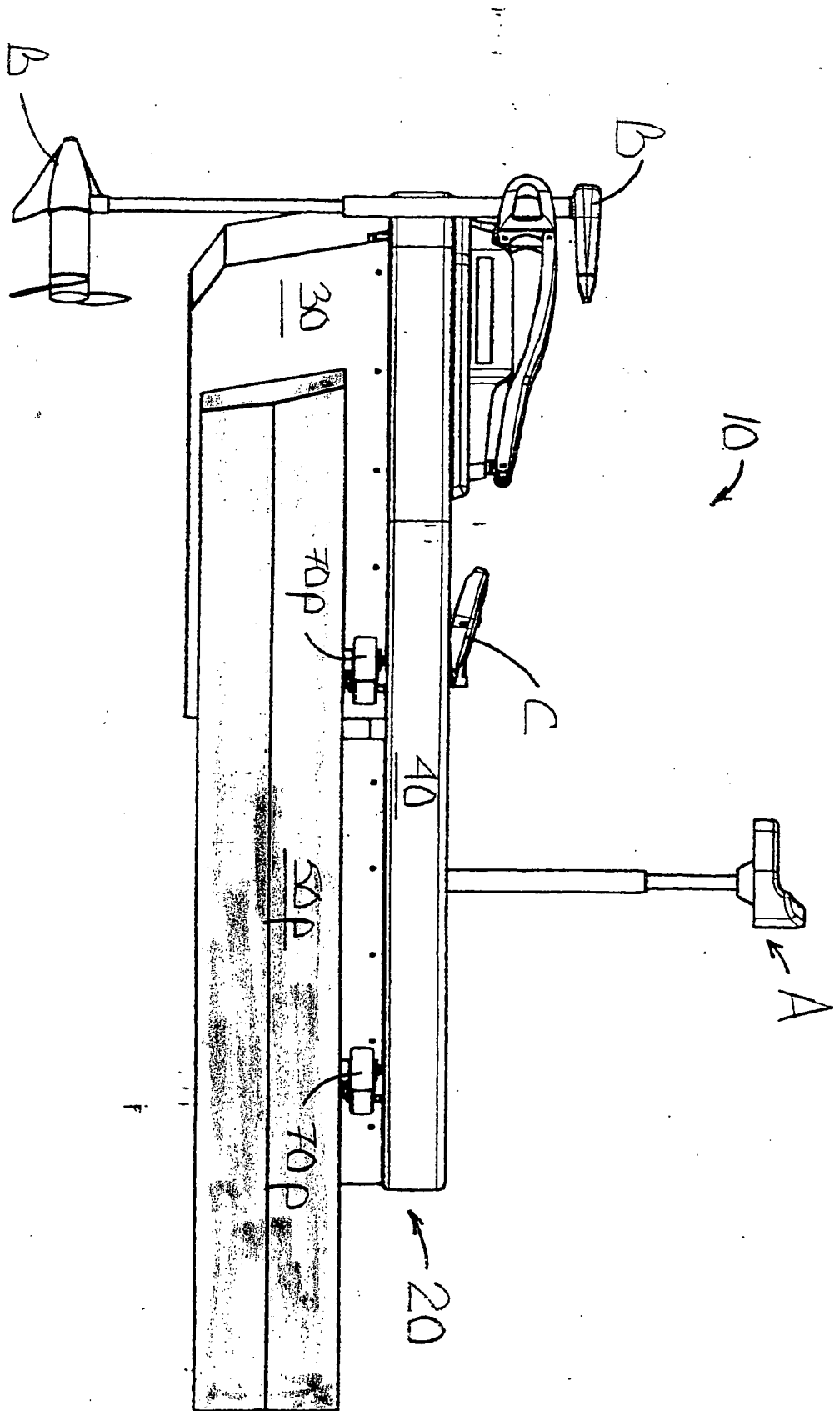


FIG. 5

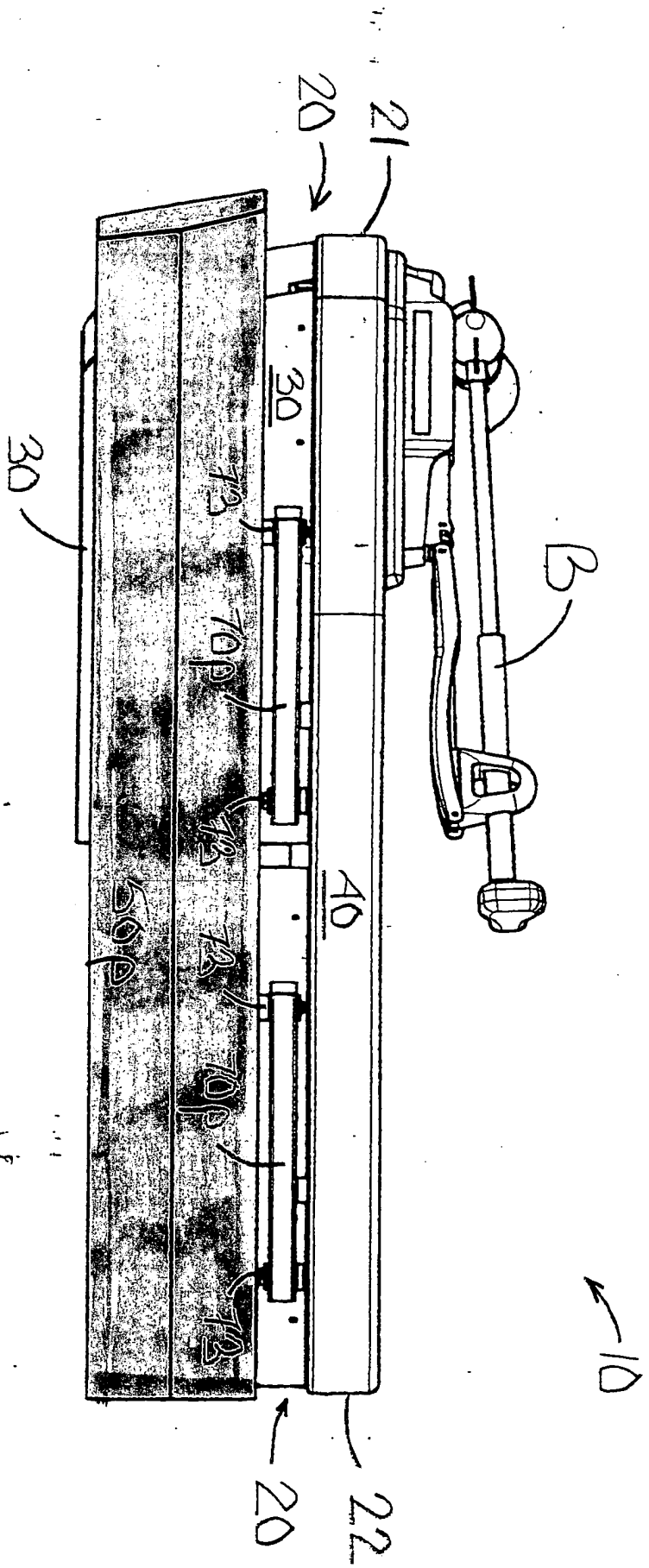


FIG. 6